

TAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 125,615

Serial No. 75/358,031

Mark: SC (Stylized)

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UNIVERSITY OF SOUTH CAROLINA,

Petitioner,

v.

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Respondent.

Opposition No. 125,615

Reg. No. 1,844,953

Mark: SC (Word Mark)

Registered: July 12, 1994

OPPOSER AND CROSS-RESPONDENT'S

REPLY PURSUANT TO BOARD ORDER DATED FEBRUARY 10, 2003

Per

I. INTRODUCTION

In its original moving and reply papers in support of this motion, the University of Southern California ("California") asked the Board to take official notice of various "SC" and "US" or "USA" registrations. California submitted these registrations to demonstrate both that the letters "SC" are not uniquely associated with the government of the state of South Carolina, and that the Patent and Trademark Office does not consider the mere initials of a state or country to be a sovereign insignia within the meaning of 15 U.S.C. § 1052(b). In its Order dated February 10, 2003, this Board indicated that it would consider the registrations submitted by California, but it provided an opportunity to submit any contrary evidence and briefing to the University of South Carolina ("Carolina") under the summary judgment standard of Fed. R. Civ. Pro. 56.

Although Carolina did submit 17 exhibits in response to the Board's Order, the exhibits do not lend any support to Carolina's claims.¹ If credited, the evidence would show only that the letters "SC" are not uncommonly associated with the government of the state of South Carolina; there is no evidence that states or even suggests that the letters "SC" are *uniquely* associated with the government of the State of South Carolina as is required under 15 U.S.C. § 1052(a). In fact, the same methods that Carolina uses to show that the letters "SC" are associated in some way with the State of South Carolina in at least 3,000 cases also show that the letters "SC" are

¹ Because Carolina submitted no declaration or other form of authentication, most of the evidence is incompetent and cannot be used for any purpose at summary judgment. F.R.C.P. 56 (e). It is well established that evidence submitted for summary judgment must be admissible, and evidence cannot be admissible without an adequate foundation. Finally, to the extent that Carolina includes material from printed publications, such material might have been admissible with a proper notice of reliance, 37 C.F.R. § 2.122(e), but no such notice was provided.

commonly associated with the Opposer/Respondent University of Southern California, and further show that there are at least 3,000 uses of "SC" that have no relationship to the state of South Carolina.

Moreover, there is no evidence that would show that the initials "SC" have been adopted by the State of South Carolina as an insignia of sovereign authority within the meaning of 15 U.S.C. § 1052(b). Carolina submits no legislation to support this claim, nor any official record of the adoption of the letters SC. [*Contrast* South Carolina General Assembly Resolution of April 2, 1776, adopting the South Carolina State Seal.] Indeed, Carolina submits no declaration that even purports to state that the government of South Carolina has adopted the letters SC as an insignia of sovereign authority.

Instead, Carolina submits various exhibits that, if competent, would do nothing more than show that the government of the state of South Carolina has used the letters SC as one element on various flags, uniforms, seals, etc on various occasions (almost exclusively before 1865).² However, this evidence does not show that the letters SC by themselves constitute an insignia of sovereign authority within the meaning of 15 U.S.C. § 1052(b). Unlike the official flag and state seal of the State of South Carolina, which South Carolina has formally adopted and which do not

² Indeed, most of the occasions reflected in the exhibits derive from the Civil War era, almost 140 years ago. Of the six exhibits which might reflect the use of SC as part of flags, uniforms, seals, etc., five of them date from before 1865. The remaining exhibit is a series of pictures of airplanes from the South Carolina Air National Guard, which shows the letters "S.C." being used as an part of an abbreviation for the South Carolina Air National Guard (*i.e.* either as "S.C. Air National Guard" or "S.C.A.N.G."). For the reasons discussed below, the inclusion of "S.C." as part of that abbreviation is not a formally adopted pictorial symbol of state authority that would make it among the flags, coat of arms, or other insignia protected by 15 U.S.C. § 1052(b).

include the letters "SC," there is no point at which the state of South Carolina has adopted the initials "SC" as a symbol of sovereign authority within the meaning of 15 U.S.C. ¶ 1052(b).

As a result, both the clear law and the undisputed evidence before this Board demonstrate that Carolina's claims under 15 U.S.C. § 1052(a) and 15 U.S.C. § 1052(b) should either be dismissed with prejudice or summarily adjudicated against Carolina.³

II. ARGUMENT

A. Carolina's Evidence Does Not Show Any Unique Affiliation of the Letters "SC" With the Government of the State of South Carolina

1. The Board Must Grant Summary Judgment When the Opposing Party Fails to Raise a Material Issue of Fact

Rule 56 provides "the principal tool [] by which factually insufficient claims or defenses [can] be isolated and prevented from going to trial." *Celotex Corp. v. Catrett*, 477 U.S. 317, 327, 106 S. Ct. 2548, 2555, 91 L. Ed. 2d 265, 276 (1986). A moving party need not submit evidence that affirmatively disproves the opposing case. *Id.* at 325; *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1575 (Fed. Cir. 1994). Rather, once an issue of summary judgment has been properly raised, the burden shifts to the opposing party to produce admissible evidence to demonstrate the existence of a triable issue of fact. *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 850 (Fed. Cir. 1992). Summary judgment is appropriate where the opposing party does not submit any admissible evidence that would create a triable issue of fact. *Schoell v. Regal Marine Indus., Inc.*, 247 F.3d 1202, 1207 (Fed. Cir. 2001).

³ As noted at the end of this memorandum, California understands the Board's order of February 10, 2003 to extend only to the subjects on which California had submitted outside registrations. As such, California will not provide further substantive briefing on its F.R.C.P. 9(b) motion to dismiss Carolina's fraud claim, which has been fully briefed in the prior papers.

Put differently, the evidence must not only create an issue of fact, it must create an issue of fact on a relevant topic. Summary judgment is proper in spite of a factual dispute, if the factual dispute would not affect the resolution of the suit under the governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 2510, 91 L. Ed. 2d 202, 211 (1986) ("Only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment"); *Olde Type Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202 (Fed. Cir. 1992).

2. 15 U.S.C. § 1052(b) Requires More than Just a Common Association Between the Mark and the Challenger: It Requires a Unique Association Between the Two

As the Trademark Manual for Examining Procedure explains:

To establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that: . . . (2) the mark would be recognized as . . . point[ing] uniquely and unmistakably to that person or institution . . . and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

T.M.E.P. § 1203.03(e) (emphasis added) (citing *In re Nuclear Research Corp.*, 16 U.S.P.Q. 2d 1316, 1317 (T.T.A.B. 1990), *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985), and *In re Cotter & Co.*, 228 U.S.P.Q. 202, 204 (T.T.A.B. 1985)).

Therefore, a mark cannot be challenged under Section 1052(b) unless the consuming public would associate the mark with only one possible source. The lead case on this subject is the Federal Circuit's *Notre Dame* decision, wherein the Federal Circuit rejected the claim that the name "Notre Dame" was uniquely associated with the University of Notre Dame. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1375-76 (Fed. Cir. 1983), *aff'g* 213 U.S.P.Q. 594 (T.T.A.B. 1982). In the words of the Federal Circuit:

[T]he initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona."

Notre Dame, 703 at 1376-77. See also *id.* at 1377 ("The mark NOTRE DAME, as used by [applicant], must point uniquely to the University.")

The Federal Circuit explained that the University's challenge failed because the name was not solely associated with the University despite the University being a "famous and distinguished" university which enjoyed "great prestige and good will around the country" .

Notre Dame, 703 F.2d at 1373-74, 1377. As a result, it could not be said that the mere use of the name "Notre Dame" appropriated the identity of the University. *Id.* at 1377 See also *National Aeronautics and Space Admin. v. Bully Hill Vineyards Inc.*, 3 U.S.P.Q. 2d 1671, 1676 (T.T.A.B. 1987) (rejecting violation where the name "does not point uniquely and unmistakably to that party's personality or 'persona'"); cf. *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985) (upholding challenge to the mark "MARGARITAVILLE" because the name is uniquely associated with the singer Jimmy Buffett).

3. Although a Lexis/Nexis Search Does Show More than 3,000 Results of "SC" in Close Proximity to "South Carolina," Lexis/Nexis Searches Also Show More than 3,000 Results of "SC" Without Any Mention of South Carolina

California has repeated the search reflected in Carolina's Exhibit 1, and confirmed that a Lexis/Nexis search does show more than 3,000 results of SC within close proximity to the words "South Carolina." [Affidavit of Mandy Robertson-Bora ("MRB Decl.") ¶ 2.] California assumes that Carolina means to show that the letters "SC" are not uncommonly associated with the words "South Carolina."

However, a similar Lexis/Nexis search on the letters "SC" that excludes any result with the words "South Carolina" likewise shows more than 3,000 results in which "SC" is used

without any mention of South Carolina. [MRB Decl. ¶ 3 and Ex. A thereto.] To the extent that Carolina's original search shows some connection in the public mind, the converse of that search shows that the letters "SC" are not uniquely associated with the state of South Carolina.

In this respect, the relationship between Carolina and "SC" is no different than the relationship between the University of Notre Dame and the "NOTRE DAME" mark. A Lexis/Nexis search using the Carolina method demonstrates that there are more than 3,000 results with "Notre Dame" in close proximity to the word "University," but a similar Lexis/Nexis search also demonstrates that there are more than 3,000 results for "Notre Dame" that do not mention the word "University" at all. [MRB Decl. ¶¶ 4-5 and Exs. B-C.] In other words, the instant case is analogous to the Notre Dame case, and the fact that people frequently (but not exclusively) associate the mark with one source does not constitute the basis for a claim under 15 U.S.C. § 1052(a). *See generally, Notre Dame*, 703 F.2d at 1377 (explaining that fame for one source is not enough to establish protection unless the mark points uniquely to that source).

4. Moreover, a Similar Lexis/Nexis Search Shows that the Letters "SC" Are Also Commonly Associated With the University of Southern California

Not only does Carolina's methodology disprove any unique association between "SC" and "South Carolina," but Carolina's methodology also demonstrates many instances where "SC" is associated with California. A Lexis/Nexis search using Carolina's methodology for SC within a close proximity to California, Southern Cal, University of Southern California or Trojan(s) resulted in more than 650 such results, with more than 200 relating to "Trojan" or "Trojans" alone. [MRB Decl. ¶ 6 and Ex. D.] Moreover, a similar Lexis/Nexis search with a slightly different methodology shows more than 2,500 results which refer to "SC," "Football" and "Trojans" all in the same document. [MRB Decl. ¶ 7 and Ex. E.] In other words, the same

methodology proposed by Carolina clearly demonstrates that California has an established connection to the letters "SC" and that the letters cannot be exclusively or uniquely associated with the government of the state of South Carolina.

5. California's Prior Evidence Demonstrates that Numerous Third Parties Use the Letters SC

In its prior briefing, California asked this Board to take official notice of various registrations to demonstrate that "SC" is not uniquely associated with Carolina. Carolina begins its objections by an attack on the "typed listings" that California submitted with its original papers. This long discussion is nothing more than an irrelevancy, since California previously submitted evidence of 11 third-party word mark registrations in conformity with TMBP § 703.02(b), and submits herewith the remainder of the registrations previously identified, in the format required by TMBP § 703.02(b).⁴ [California's Notice of Reliance ("NOR"), Section C and Ex. C thereto.] It is well established that such evidence of third party registrations is admissible evidence on summary judgment. *Id.*; 37 C.F.R. § 2.122(e); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626 (8th Cir. 1987).

Carolina then attempts to dismiss the 11 word marks for "SC" by contending that each situation should be determined on its own merits, and the submission of evidence of third-party marks should not be given any weight in determining the strength or weakness of a mark.

Again, Carolina's argument misses the point. Of course each case has to be determined on its individual facts. In this case, the fact in question is whether Carolina has alleged a unique

⁴ As California brought this motion initially under Fed. R. Civ. Pro. 12 rather than Fed. R. Civ. Pro. 56, California did not believe that the standards of TMBP § 703.02(b) applied. However, to address Carolina's objections, California submitted all of the "SC" word marks it had previously identified under the standards of TMBP § 703.02(b) in prior briefing.

and exclusive association between that the letters "SC" and the government of South Carolina. Given the nature of Carolina's claims, the evidence of third party registrations is clear evidence that third parties have used and continue to use the letters "SC" for purposes unconnected with South Carolina.

Moreover, Carolina's citation of *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200 (Fed Cir. 1992) does it more harm than good. Although third-party registrations may not be evidence of the strength or weakness of the mark, such registrations "nevertheless are relevant when evaluating the likelihood of confusion." *Olde Tyme*, 961 F.2d at 204. Put differently, such registrations show a diminished likelihood of confusion, because they show that the asserted mark is not particularly unique. This Board may consider them on the facts of this case for exactly that purpose: that the "SC" mark is not particularly unique to the source claiming exclusive possession of it for all purposes. *See also General Mills*, 824 F.2d at 626-27.

6. This Board May Consider Additional Facts From Dictionaries that Disprove Any Unique Association

In its original motion, California asked the Board to take official notice of the fact that SC is the official international postal code for the Seychelles Islands, and that SC is likewise the element code for the element Scandium. [Request for Official Notice ¶¶ 12-13]. The Board is entitled to consider such entries in dictionaries and other appropriate publications. 37 U.S.C. § 2.122(e); *see also Loglan Inst., Inc. v. Logical Lang. Group, Inc.*, 962 F.2d 1038, 1041 (Fed. Cir. 1992).

In addition to the evidence submitted with its original motion, California herewith submits the relevant pages from volume 1, part 4 of the *Acronyms, Initialisms & Abbreviations Dictionary*, 29th Ed. 2001 at pp. 2799-3803 (Mary Rose Bonk, Ed.) [NOR, Section B and Ex. B thereto.] This dictionary contains more than four pages of different meanings for the initials SC,

which includes "Southern California." [Ex. B at 3801.] This is yet additional evidence that the letters "SC" are not uniquely associated in the public perception with the government of South Carolina.

7. Because Carolina Submits No Evidence That Demonstrates or Even Suggests a Unique Affiliation of the Letters "SC" to the Government of the State of South Carolina, Its Challenge Under 15 U.S.C. § 1052(a) Must Fail

Beyond the Lexis/Nexis search, Carolina submits various exhibits that reflect the use of the letters "SC" in various ways that refer to the state of South Carolina (such as the BlueBook, various maps, various S. Carolina governmental websites, etc.). However, none of these exhibits demonstrates or suggests a unique affiliation between the letters "SC" and the government of the state of South Carolina that would exclude other uses.⁵ Carolina asks this Board to take an unacceptable logical leap: that merely because there are many instances in which the letters "SC" refer to South Carolina, the Board should presume that the letters "SC" refer to the government of South Carolina in every instance. Carolina's evidence does not support the second proposition.

The plain fact is that Carolina has failed to submit any evidence that would prove the second proposition. There is no declaration from any individual for the proposition that the letters "SC" are uniquely associated with South Carolina. There is no evidence (competent or

⁵ Indeed, not only does Carolina fail to submit any evidence that would show a unique association with the government of the state of South Carolina, at least one of Carolina's exhibits shows that the letters "SC" are used to refer to other, non-governmental affairs within the borders of South Carolina. *See, e.g.* Carolina Exhibit 6 (discussing "SC Weather Forecasts," "SC Tides," "SC Restaurants," "SC Bands & Music"). Although not one of the thousands of uses of SC that is completely unrelated to "South Carolina," this is further demonstration that the letters "SC" do not refer exclusively to the governmental entity which claims it here.

otherwise) that tends to exclude any other connection with "SC," and indeed, there is no attempt to show a unique connection. In effect, Carolina is back where it began: resting on its bare allegation that the letters "SC" are uniquely associated with the State of South Carolina despite the evidence to the contrary. Such an allegation is not sufficient for summary judgment.

As discussed in the opening portion of this brief, Carolina's burden on summary judgment is to present admissible evidence that would create a relevant issue of triable fact, and California could prevail even if it had not submitted any evidence at all (although it has). The bottom line is that Carolina has not submitted any evidence (admissible or not) that would support its claim that the letters "SC" are uniquely associated with the government of the state of South Carolina, and its claim must fail. *Notre Dame*, 703 F.2d at 1377.

B. None of Carolina's Evidence Demonstrates that Carolina Uses SC as an Insignia Within the Meaning of 15 U.S.C. § 1052(b)

1. 15 U.S.C. § 1052(b) Requires That the Insignia Be a Pictorial Symbol of State Authority

15 U.S.C. § 1052(b) provides that a mark shall not register if the mark:

Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

15 U.S.C. § 1052(b).

As the Trademark Manual of Examining Procedure explains:

Flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority. The wording "other insignia" should not be interpreted broadly, but should be considered to include only those emblems and devices that also represent such authority and that are of the same general class and character as flags and coats of arms.

T.M.E.P. § 1204 (3d. ed. rev. June 2002) (emphasis added); *see also Vuitton Et Fils S.A. v. J. Young Enter., Inc.*, 644 F.2d 769, 775 (9th Cir. 1981) (rejecting § 1052(b) claim because challenged mark was not an "official symbol" of the government).

In addition, as Judge Flannery has explained, an image must be "formally adopted to serve as an emblem of governmental authority" in order to qualify as an insignia under § 1052(b). *Heroes, Inc. v. Boomer Esiason Hero's Found., Inc.*, 43 U.S.P.Q. 2d 1193, 1198 (D.D.C. 1997). Moreover, as noted in the moving papers, this Board has previously addressed the question of initials and found that they are not generally protectable under § 1052(b). *U.S. Navy v. United States Mfg. Co.*, 2 U.S.P.Q. 2d. 1254, 1256 (T.T.A.B. 1987) ("The letters 'USMC' are nothing like a flag or coat of arms. These types of insignia are pictorial in nature, they can be described, but cannot be pronounced.").

Among the reasons that § 1052(b) is interpreted so narrowly is that § 1052(b) precludes the registration of any mark that would include a forbidden insignia. TMEP § 1204 (prohibition extends to marks "having [objectionable material] incorporated in them"). As a consequence, a liberal interpretation of the definition of insignia in § 1052(b) would effectively preclude any registration that included the letters SC or any similar initialing for any state or country (*i.e.* the letters "DC," "NY," "UK," etc. could not be included in any application or registration.) The goal of § 1052(a) is to prevent the dilution of pictorial symbols of state authority like a flag or coat of arms, not to exclude any mark which might happen to incorporate the initials of a sovereign. *See generally In re Horwitt*, 125 U.S.P.Q. 145 (T.T.A.B. 1960) (approving registration of "U.S. Health Club" over objection that mark included a designation for the United States).

As such, it is clear that the letters SC do not meet the narrow standards prescribed for flags, coats of arms, or other insignia under 15 U.S.C. § 1052(b).⁶

2. While South Carolina Has Formally Adopted Various Flags and Seals, South Carolina Has Never Adopted Any Form of "SC" as an Official Insignia

It is notable that Carolina does not submit any official resolutions of the state of South Carolina or any other official action that adopts the letters "SC." Indeed, Carolina does not even submit any declaration from anyone holding any responsible position in the South Carolina government (or anyone else) to the effect that the letters "SC" have been adopted as a symbol by the government of South Carolina.

As California notes in its accompanying Notice of Reliance, the government of South Carolina maintains at least one website that identifies the "Symbols and Emblems" of the State of South Carolina. [NOR Section A and Ex. A thereto.] That website not only identifies the various flags and seals of the State of South Carolina, but it also typically identifies the dates on which those flags or seals were adopted or modified by the State of South Carolina. *See generally* <http://www.lpitr.state.sc.us/studentpage/symbols.htm>. For example, the official state seal for the State of South Carolina was adopted by formal resolution of South Carolina's General Assembly on April 2, 1776. [*Id.* at NOR Ex. A.] Of course, that seal does not consist

⁶ California notes that, of all of the exhibits submitted by Carolina, only the buttons in Exhibit 14 reflect the sort of pictorial representations of state authority contemplated by § 1052(b). Of course, these representations consist of more than just the letters SC. Moreover, as discussed in the following section, there is no evidence that the seals in Exhibit 14 were ever formally adopted by the State of South Carolina (unlike South Carolina's official state seal, which was formally adopted on April 2, 1776).

merely of the letters "SC." As a point of fact, the official seal does not even contain the letters "SC." [*Id.*]

As this Board may have expected given the lack of evidence from Carolina, the website does not include any mention of the letters "SC" as an adopted symbol. *Id.* Moreover, the letters "SC" are not even present within the seals and flags that have been formally adopted. *Id.*

The only evidence that Carolina submits shows at best, if admissible at all, that the letters SC were included on various uniforms, regimental flags, and similar military items. While Carolina announces in a conclusory fashion, that the inclusion of the letters "SC" on such uniforms and regimental flags demonstrates a formal adoption by the state of South Carolina, this announcement is really an attempt to finesse the fact that South Carolina has never formally adopted the letters "SC" as a symbol of sovereign authority. The mere use by a government of various symbols does not make the symbols into insignia of sovereign authority. *In re U.S. Department of the Interior*, 142 U.S.P.Q. 506, 507 (TTAB 1964) (rejecting claim that use by government department constitutes "other insignia" because such insignia is not a formally adopted symbol of the entire government).

Moreover, the use by South Carolina of the initials "SC" on various uniforms and similar military paraphernalia is no different (if far less extensive) than the use of the letters "US" on various military uniforms and paraphernalia of the United States Government. Nevertheless, a myriad of "US" marks have registered, which demonstrates clearly that the mere inclusion of a sovereign's initials on a uniform or similar military paraphernalia does not constitute a formally adopted pictorial insignia within the meaning of 15 U.S.C. § 1052(b).

In short, the law under 15 U.S.C. § 1052(b) is quite clear that an "insignia" under the meaning of that section must be a symbol of state authority that is a) pictorial and b) formally

adopted as a symbol for the entire sovereignty rather than a mere portion thereof. The letters "SC" meet neither of these qualifications and 15 U.S.C § 1052(b) is not a bar to registration of the letters "SC" by the University of Southern California or any other applicant.

C. California Relies Upon Its Previous Briefing In Regards to Its Fed. R. Civ. Pro. 9(b) Motion Against Carolina's Fraud Allegations

Although Carolina submits additional argument directed towards California's motion under Fed R. Civ. Pro. 9(b), Carolina does not submit any additional evidence to support its claim that California's statement of first use was submitted with fraudulent intention, or its generic claim without any factual allegations that the Board must have relied on the alleged misstatements. Carolina simply argues that there is sufficient ambiguity in California's statement of first use that the Board should allow the allegation of fraud to go forward.

In its prior briefing, California explained at length how California's actual affidavit does not contain the misstatements alleged by Carolina. California further explained at length why, even if they had been made, the alleged misstatements could not have been material to the Examiner's decision to allow the registration or constitute a "but for" cause of registration. Rather than burden this Board by repeating that argument here, California will only note that the existence of a mere ambiguity is not enough under Fed. R. Civ. Pro. 9(b) to support a claim for fraudulent statement or intent, and ambiguity is certainly not a specific factual allegation to explain why the Examiner would have relied on the alleged misstatement. As discussed at much greater length in California's previous briefing, the few concrete allegations in the complaint do not demonstrate an actual misstatement as required by Fed. R. Civ. Pro. 9(b), and moreover, such an alleged misstatement would not have precluded registration since the registration would have issued given the undisputed fact that California was using the mark in commerce on all of the

goods by the time it filed its statement of first use. California therefore directs the Board to that previous briefing.

IV. CONCLUSION

For the reasons discussed above, Carolina's counter-claim should be dismissed as a matter of law.

Dated: April 1, 2003

Respectfully submitted,

GIBSON, DUNN & CRUTCHER, LLP



Scott A. Edelman
Michael S. Adler
2029 Century Park East, Suite 4000
Los Angeles, CA 90067-3026
Telephone: (310) 552-8500

Attorneys for Opposer
University of Southern California

Reference no. 93107-00125

Opposition No. 125,615

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER AND CROSS-RESPONDENT'S REPLY PURSUANT TO BOARD ORDER DATED FEBRUARY 10, 2003** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 1st day of April, 2003.

John C. McElwaine
Matthew D. Patterson
Nelson Mullins Riley & Scarborough, L.L.P.
Liberty Building, Suite 500
Charleston, South Carolina 29401

Attorneys for Applicant University of South Carolina


Mandy Robertson-Bora

CERTIFICATE OF EXPRESS MAILING UNDER 37 § CFR 1.10

I hereby certify that on April 1, 2003, the attached **OPPOSER AND CROSS-RESPONDENT'S REPLY PURSUANT TO BOARD ORDER DATED FEBRUARY 10, 2003** (re Opposition No. 125,615) is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

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Mandy Robertson-Bora

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